

PTO/SB/21 (09-04)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number 09/635,330

Filing Date August 9, 2000

First Named Inventor Gutierrez-Sheris

Art Unit 3624

Examiner Name Karmis

Attorney Docket Number 25153-003

ENCLOSURES (Check all that apply)

- | | | |
|---|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
| <input checked="" type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input checked="" type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input checked="" type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter |
| <input checked="" type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Request for Refund | Request for Continued Examination transmittal, Return postcard |
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| | <input type="checkbox"/> Landscape Table on CD | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="text"/> Remarks | |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application | | |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Cowan, Liebowitz & Latman, P.C.		
Signature			
Printed name	Mark Montague		
Date	May 25, 2006	Reg. No.	36,612

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Mark Montague	Date	May 25, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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FEE TRANSMITTAL

For FY 2006

Complete if Known

Application Number 09/635,330
 Filing Date August 9, 2000
 First Named Inventor Gutierrez-Sheris
 Examiner Name Stefanos Karmis
 Art Unit 3624
 Attorney Docket No. 25153-003

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 455.00

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 03-3415 Deposit Account Name: Cowan Liebowitz & Latman

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP =	x	=
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP =	x	=
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$)

- 100 = / 50 = (round up to a whole number) x = Fee Paid (\$)

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Extension of time fee: RCE fee

Fees Paid (\$)

455.00

SUBMITTED BY

Signature

Registration No. 36,612
(Attorney/Agent)

Telephone 712-790-9200

Name (Print/Type) Mark Montague

Date May 25, 2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Atty Ref: 25153-003

S/N: 09/635,330

Art Unit: 3624

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May 25, 2006.

Date of Deposit

Mark Montague

Attorney

Signature

May 25, 2006

Date of Signature

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Atty Ref: 25153-003

S/N: 09/635,330

Art Unit: 3624

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Luis Eduardo Gutierrez-Sheris

Examiner: Karmis, Stefanos

Group Art Unit: 3624

Serial No.: 09/635,330

Filed: August 9, 2000

For: MONEY-TRANSFER TECHNIQUES

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Response to Final Office Action

This is in response to the final office action dated January 30, 2006, the time for responding thereto having been requested to be extended.

Claims 1-61 were rejected under 35 U.S.C. 103(a) as being unpatentable over O'Leary et al. ("O'Leary") (U.S. Patent 6,609,113) in view of Downing et al. ("Downing") (U.S. Patent 5,963,647) in further view of Tadesco et al. ("Tadesco") (U.S. Patent 6,085,888).

In Applicant's prior response filed November 7, 2005 (dated November 3, 2005), it was asserted that the O'Leary patent is not valid prior art to the present application and a Declaration under 37 C.F.R. 1.131 accompanied that response in an attempt to establish a date of invention of the present application that pre-dates the priority filing date of the O'Leary patent. For purposes of that submission, it was

assumed that the O'Leary patent was entitled to a priority filing date of May 3, 1999, which corresponded to the filing date of the earliest provisional patent application to which priority was claimed in the O'Leary patent.

In response to Applicant's submission filed November 7, 2005, the Examiner deemed the declaration under 37 C.F.R. 1.131 ineffective to overcome the O'Leary Patent. Specifically, the Examiner stated that "there is no statements regarding time periods from May 3, 1999 when the invention was conceived until it was filed on 05 January 2000 sufficient to established [sic] diligence." (Final Office Action, page 3). Since the Examiner did not specify the period of time for which diligence allegedly was not sufficiently specified or established, the file history suggests that the time for which diligence is lacking in evidence is the earlier portion of the time period since the Examiner had accepted applicant's first filed declaration under 37 C.F.R. 1.131 which effectively established a date of invention prior to the October 26, 1999 filing date of the previously cited Stoutenburg patent (U.S. Patent 6,488,203).

Now, after having reviewed all of the provisional applications (5 in all) to which the O'Leary Patent claims priority, it is submitted that the O'Leary Patent is not entitled to a priority filing date of May 3, 1999. Instead, and as established by the foregoing discussion, it is submitted that the O'Leary Patent is entitled, for purposes of the Examiner's rejection, arguably at best to a priority filing date of October 26, 1999, which is the filing date of the third provisional application.

The O'Leary Patent claims priority to five (5) provisional applications. The first and second provisional applications clearly do not disclose subject matter relied upon by the Examiner in the office action under reply, as follows:

The first provisional application, attached hereto in appendix A, was filed on May 3, 1999, and discloses subject matter for making purchasing from a merchant. The first provisional application does not include any discussion with respect to the transfer of money to another person and also does not include any discussion with respect to use of a card for any purpose whatsoever. Accordingly, the first provisional application does not disclose subject matter on which the Examiner relies to reject the claims in the application.

The second provisional application, attached hereto in appendix B, was filed on August 25, 1999, and additionally discloses (beyond that already disclosed in the first provisional application) the transfer of money to a recipient's bank account. Based upon a comparison of the first and second provisional applications, newly added subject matter in the second provisional application principally is set forth at page 5, lines 9-13; page 8, lines 3-14; page 9, lines 3-8; page 10, lines 1-3; page 13, lines 13-20; and page 15, lines 4-25. Each of these sections in the second provisional application relate to the transfer of money to another individual's bank account. Accordingly, the second provisional application does not disclose subject matter on which the Examiner relies to reject the claims in the application.

As for the teachings of the third, fourth and fifth provisional applications, attached hereto respectively in Appendices C, D and E, it further appears that these

applications or at least the third application (and possibly the 4th application) also does not provide support for the Examiner rejections. However, based upon a review of the O'Leary patent itself, it is questioned that this reference actually teaches various features of the claimed invention, as relied upon by the Examiner in the office action under reply. But since this gets to the merits of O'Leary, and it is currently submitted that O'Leary is not valid prior art to the present application in the first place, the merits of O'Leary are not be addressed herein. Moreover, applicant reserves the right to later argue that O'Leary is not entitled to the filing date of the third provisional application, should the need arise.

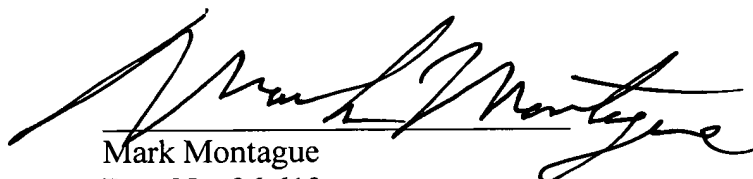
In view of the foregoing, it is submitted that the O'Leary Patent is entitled arguably, at best, to a priority filing date of October 26, 1999. Accordingly, it is submitted that the two previously submitted declarations under 37 C.F.R. 1.131 effectively establish an invention date of the present application that precedes October 26, 1999. To summarize the facts, the present application was filed on August 9, 2000, and claims priority to provisional patent application serial number 60/174,646, which was filed on January 5, 2000. A document dated June 25, 1999, submitted with the previously submitted declaration under 37 C.F.R. 1.131 (in appendix A), illustrates the invention was fully conceived of at least as of this date. Then, in at least as early as July, 1999, the applicant began the patenting process, wherein a patentability search was first commenced followed by patent counsel's (former patent counsel) efforts to prepare the U.S. provisional application that was filed on January 5, 2000. As supported by case law, the time period involving patent counsel's efforts

in such a matter "counts" towards the diligence requirement between conception of the invention and either actual or constructive reduction to practice.

It is further noted that the filing date of the third provisional application of O'Leary, that is, October 26, 1999, coincidentally was the filing date of the previously cited Stoutenburg patent, and the submission of applicant's first declaration under 37 C.F.R. 1.131 successfully established an earlier invention date thereby causing a rejection based upon the Stoutenburg patent to be withdrawn. It then follows that the O'Leary patent likewise is not prior art under 35 U.S.C. 102(e). It is therefore respectfully requested that the rejection of claims 1-61 under 35 U.S.C. 103(a) as being unpatentable over O'Leary in view of Downing et al. in further view of Tadesco et al. be withdrawn.

In light of the foregoing, reconsideration and allowance of this application are respectfully requested.

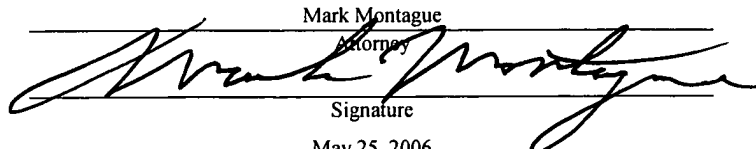
Respectfully submitted,


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Date of Deposit

Mark Montague
Attorney


Signature

May 25, 2006

Date of Signature

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